

**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

32

Application Number

10/538,160

Filing Date

June 8, 2005

First Named Inventor

Danny A. Grant

Art Unit

unassigned

Examiner Name

George Dombroske

Attorney Docket Number

IMMR-0152A (034701-510)

**ENCLOSURES (check all that apply)**☐ Fee Transmittal Form☐ Fee Attached☐ Amendment / Reply☐ After Final☐ Affidavits/declaration(s)☒ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Reply to Missing Parts/  
Incomplete Application☐ Reply to Missing Parts  
under 37 CFR1.52 or 1.53☐ Drawing(s)☐ Licensing-related Papers☐ Petition☐ Petition to Convert to a  
Provisional Application☐ Power of Attorney, Revocation  
Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) \_\_\_\_\_☐ Landscape Table on CD☐ After Allowance Communication to TC☐ Appeal Communication to Board  
of Appeals and Interferences☐ Appeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☒ Other Enclosure(s)  
(please identify below):Response to dismissal of request to  
change inventorship; Credit card payment  
form; Copy of decision; Five complete  
copies of Declaration & Power of Attorney  
documents**Remarks****SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm

Thelen Reid Brown Raysman &amp; Steiner LLP

Signature



Printed Name

Khaled Shami

Date

March 1, 2007

Reg.  
No.

38,745

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Signature



Typed or printed name

Monica Pizarro

Date

March 1, 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT: Danny A. Grant et al.  
SERIAL NO.: 10/538,160  
FILING DATE: June 8, 2005 CONFIRMATION NO.: 3287  
TITLE: Methods And Systems For Providing Haptic Messaging To Handheld  
Communication Devices  
EXAMINER: George Dombroske  
TELEPHONE: (571) 272-3283  
FAX: (571) 273-0459  
ART UNIT: unassigned

---

**CERTIFICATE OF MAILING**

I hereby certify that this paper is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, on the date printed below:

Date: 3/1/07

Name:   
Monica Pizarro

---

Mail Stop PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Response to Dismissal of Request to Change Inventorship  
Under 37 CFR 1.497(d), and Request for Reconsideration**

Sir:

Reconsideration of the dismissal of the request to change inventorship under 37 CFR 1.497(d) is respectfully requested. The request was dismissed due to Applicant's stated failure to meet requirements (3) and (4) of 37 CFR 1.497(d).

Regarding requirement (3), the assignment as been recorded, in **Reel 017847/Frame 0531**.

Regarding requirement (4), submitted herewith are five complete Declaration & Power of Attorney documents. Applicants respectfully submit that the uninitialed alteration in the


document signed by inventor Shahoian was merely to correct a typographical error. This is evidenced by the fact that “Shahoian” is correctly spelled in a different part (page 3) of the same Declaration document. Moreover, the alteration is merely to the printed portion of Mr. Shahoian’s name, above which his complete signature—not merely his initials—is provided.

Early favorable consideration is respectfully requested.

Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,  
THELEN REID BROWN RAYSMAN & STEINER LLP

Dated: March 1, 2007

  
\_\_\_\_\_  
Khaled Shami  
Reg. No. 38,745

THELEN REID BROWN RAYSMAN & STEINER LLP  
P.O. Box 640640  
San Jose, CA 95164-0640  
Tel: (408) 292-5800  
Fax: (408) 287-8040



**COPY**

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

THELEN REID & PRIEST L.L.P.  
P.O. BOX 640640  
SAN JOSE CA 95164-0640

02 OCT 2006

**RECEIVED**

OCT 04 2006

THELEN REID & PRIEST  
IP DOCKETING

In re Application of  
Grant et al.  
Application No.: 10/538,160  
PCT No.: PCT/US03/38899  
Int. Filing Date: 08 December 2003  
Priority Date: 08 December 2002  
Attorney Docket No.:IMMR-0152A (034701-000510)  
For: Methods And Systems For Providing Haptic :  
Messaging To Handheld Communication Devices :

DECISION

This is in response to the "Petition To Correct Inventorship Under 37 CFR 1.497" filed on 27 June 2006, which is being treated under 37 CFR 1.497(d).

### BACKGROUND

This international application was filed on 08 December 2003, claimed an earlier priority date of 08 December 2002, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 08 June 2005. Applicant filed *inter alia* the basic national fee on 08 June 2005.

On 23 February 2006, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant, requiring the submission of an executed oath or declaration and a surcharge under 37 CFR 1.492(h).

### DISCUSSION

The declaration of the inventors filed on 27 June 2006 nominates two inventors, Erik J. Shahoian and Dean C. Chang, who were not nominated in the published international application, nor is an appropriate Form PCT/IB/306 present in the application file. Counsel requests treatment under 37 CFR 1.497. A declaration filed under 37 CFR 1.497 (d) must be by the actual inventor or inventors as required under 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47. The declaration must be accompanied by (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part, (2) the processing fee set forth in 37 CFR 1.17; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (*See* 37 CFR 3.73(b)). *See* Section 201.03 of the Manual of Patent Examining Procedure (M.P.E.P.).

Regarding requirement (1), applicants have provided an appropriate statement by each of Erik J. Shahoian and Dean C. Chang.

Regarding requirement (2), the required processing fee has been paid.

Regarding requirement (3), the "Consent of Assignee" document included among the instant correspondence is signed on behalf of Immersion Corporation by Laura Peter in the capacity of "Vice President and General Counsel," and who further states that she is "authorized to execute this Consent of

DOCKETED  
OCT 05 2006

Assignee." The "Consent of Assignee" is accompanied by a "Statement Under 37 CFR 3.73(b)," also signed by Ms. Peter, which asserts that Immersion Corporation is "the assignee of the entire right, title and interest" in this application. The "Statement..." references attached "copies of assignments or other documents in the chain of title." A copy of an assignment document has provided; however, the assignment is accompanied by neither an instruction to record the assignment nor by a statement specifying where documentary evidence of a chain of title is recorded in the assignment records of the USPTO (e.g., reel and frame number). As such, applicants have failed to comply with 37 CFR 3.73(b). Therefore, requirement (3) has not been satisfied.

Inspection of the declaration filed on 27 June 2006 reveals that it appears to have been assembled by aggregating individual sheets signed by each of the inventors into a single document. Since counsel has not provided copies of the complete declaration documents signed by each inventor, it is not clear that each inventor had the benefit of signing a complete copy of the declaration document. Moreover, the declaration includes an uninitialed alteration to Mr. Shahoian's name. Therefore, it would not be appropriate to grant the requested relief at this time.

### CONCLUSION

The request under 37 CFR 1.497(d) is DISMISSED, without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely reply will result in ABANDONMENT of this application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.497(d)". No additional processing fee is required.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



Leonard Smith  
PCT Legal Examiner  
Office of PCT Legal Administration



George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283  
Fax: (571) 273-0459